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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/531,809

04/18/2005

Thierry Granier

102790-189 (30061 US)

3684

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EXAMINER

NGUYEN, THUY-AI N

ART UNIT

PAPER NUMBER

1796

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/531,809	<b>Applicant(s)</b> GRANIER ET AL.	
	<b>Examiner</b> THUY-AI N. NGUYEN	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 10-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 10-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04/18/2005</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112/ 101***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-2, and 10- 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-2, and 10- 14 are provides for the use of cyclooctenyl compound of formula I, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 1-2, and 10- 14 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, and 10- 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Freerksen et al. (Journal of Organic Chemistry, 1983, vol. 48, pages 4087- 4096).

Regarding claims 1-2, and 10- 14, Freerksen et al. teach the 1-cyclooctene-1-enylketone that has the similar structure as claimed by the applicant, wherein X is carbonyl, and R is ethane, and the double bond is in the position between C1 and C2 (table 2, compound n, p. 4092).

However, Cantrell et al. do not teach that the compound is able to use as fragrance. The Office realizes that all of the claimed effects or physical properties are not positively stated by the reference(s). However, the reference(s) teaches all of the claimed ingredients. Therefore, the claimed effects and physical properties, i.e. being use in fragrance application, household product, laundry product, body care product or cosmetic would implicitly be achieved by a composition with all the claimed ingredients. If it is the applicant's position that this would not be the case: (1) evidence would need to be provided to support the applicant's position; and (2) it would be the Office's position that the application contains inadequate disclosure that there is no teaching as to how to obtain the claimed properties with only the claimed ingredients.

Claims 17 is rejected under 35 U.S.C. 102(b) as being anticipated by Cantrell et al. (Journal of Organic Chemistry, 1971, vol. 36, pages 670 – 676).

Regarding claim 17, Cantrell et al. teach the acetyl cyclooctene compound (5 and 6) that has the similar structure as claimed by the applicant, wherein X is carbonyl, and R is methyl, and the double in the position of the compound Ia and Ic as claimed by the applicant (p. 671).

Claim 18 is rejected 102(a) by Bajgrowicz et al. (Bioorganic and Medicinal Chemistry, 2003, vol. 11, pages 2931- 2946),

Regarding claim 18, Bajgrowicz et al. teach 1-cycloocten-1-yl- 4- pentene-1-one compound (compound 28d, table 1. p. 2934), wherein X is carbonyl, double bond is in position between C1 and C2, and R is pentenone.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15- 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freerksen et al. (Journal of Organic Chemistry, 1983, vol. 48, pages 4087- 4096) as applied to claim 1 above, and further in view of Markert et al. (US. 6,555,517).

Regarding to claims 15 and 16, Freerksen et al. teach the 1-cyclooctene-1-enylethanone compound. However, Freerksen et al. do not teach the method of manufacturing a fragrance composition from the compound as claimed. Markert et al. teach the method of making a fragrance composition from the 4-cyclooctene aldehyde (abstract, and col 3: 15- 41). Because cyclooctene aldehyde and 1-cyclooctene-1-enylethanone compounds have the same bone structure of cyclooctene and the functional group carbonyl, they would have similar properties. At the time of the invention, it would have been obvious to one of ordinary skill in the art to substitute 1-cyclooctene-1-enylethanone for 4-cyclooctyl aldehyde in the fragrance composition for the same purpose of using 4-cyclooctyl aldehyde as perfume or perfume booster (Markert et al., col. 3: 15 - 20, and MPEP. 2144.09).

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Freerksen et al. (Journal of Organic Chemistry, 1983, vol. 48, pages 4087- 4096).

Regarding claim 19, Freerksen et al. teach the 1-cyclooctene-1-enylethanone that has the similar structure as claimed by the applicant, wherein X is carbonyl, and R is ethane, and the double bond is in the position between C1 and C2 (table 2, compound n, p. 4092).

However, the compound does not have the double bond in the position of C4 as claimed by the applicant. A prima facie case of obviousness may be made when chemical compounds have very close structural similarities and similar utilities. "An obviousness rejection based on similarity in chemical structure and function entails the

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motivation of one skilled in the art to make a claimed compound, in the expectation that compounds similar in structure will have similar properties.” In re Payne, 606 F.2d 303, 313, 203 USPQ 245, 254 (CCPA 1979). See In re Papesch, 315 F.2d 381, 137 USPQ 43 (CCPA 1963) (discussed in more detail below) and In re Dillon, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1991) (discussed below and in MPEP § 2144) for an extensive review of the case law pertaining to obviousness based on close structural similarity of chemical compounds. See also MPEP § 2144.08, paragraph II.A.4.(c).

### **Correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THUY-AI N. NGUYEN whose telephone number is (571)270-3294. The examiner can normally be reached on Monday-Friday: 8:30 a.m. - 5:00 p.m. eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on 571-272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Eashoo/  
Supervisory Patent Examiner, Art Unit 1796  
5-Mar-08

February 29, 2008  
Patent Examiner  
Thuy- Ai N. Nguyen